

REMARKS

Reconsideration is respectfully requested. Claims 1, 4, 9, 12, 15, 17, 18, 22-25 and 27-36 are pending. Claims 1, 9 and 29 have been amended. Claims 2, 3, 5-8, 10, 11, 13, 14, 16, 19, 20, 21, 26 and 32-33 have been canceled. Claims 18 and 22-25 are withdrawn. Applicants thank the Examiner for allowance of claims 17, 30, 31 and 34-36. No new matter has been added due to the amendments. Amendment to and cancellation of the claims does not affect inventorship.

Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections made by the Patent Office. Applicants reserve the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional applications.

Claim Amendments

Claims 1, 9 and 29 have been amended for technical clarity. Support for the amendments to claims 1 and 9 can be found in the Specification at paragraphs [00196] to [00198].

Objection to the Specification

The Examiner has objected to the Specification. Applicants have amended paragraph [0044] of the Specification. The instant amendment obviates the objection to the Specification.

Claim Rejection - 35 U.S.C. § 112, First Paragraph

Claims 1, 4, 9, 12, 15, 17 and 27-29 and 32-33 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description and enablement requirement. Applicants respectfully traverse as follows:

The courts have described the essential question to be addressed in a description requirement issue in a variety of ways. An objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date

sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983)). **The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.** See M.P.E.P. § 2163.02 (emphasis added).

The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498,

I. Written Description and Enablement

Claims 1, 4, 9, 12, 15, 27-29 and 32-33 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description and enablement requirement.

The claim recitation that the protein-complex is residues 24-295 of SEQ ID NO:3 complexed to a ligand that is bound to the ATP-binding site of the protein is enabled because given the exact protein sequence and space group and unit cell parameters, the variables for which one skilled in the art would have to screen for is simplified to one, e.g., the ATP-binding site ligand which is reasonable and would not necessitate any undue experimentation. Additionally, the protein claimed in the instant claims have been described and enabled because of the considerable detail of the precise protein sequence and space group and unit cell parameters provided in the Specification.

Without acquiescing to the propriety of the rejection, Applicants have amended claims 1 and 9 in order to clarify the scope of the claims. Therefore, Applicants request that the written description and enablement rejections with respect to claims 1, 4, 9, 12, 15, 27-29 and 32-33 be withdrawn.

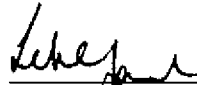
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CONCLUSION

In view of the foregoing amendments and arguments, it is believed that all claims now pending in this application are in condition for allowance. Should the Examiner not agree, the Applicant respectfully asks the Examiner to contact the undersigned at the phone number below to discuss any remaining issues and accelerate the examination and allowance of this application. Authorization is granted to charge any outstanding fees due at this time for the continued prosecution of this matter to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310 (Client Matter No. 067450-5016US).

Respectfully submitted,
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